



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/688,066	10/13/2000	Dr. Biancamaria Prozzo	TP/2-22108/A/PFE 287	1274

7590

07/30/2003

Ciba-Specialty Chemicals Corporation  
Patent Department  
540 White Plains Road  
PO Box 2005  
Tarrytown, NY 10591-9005

EXAMINER

KUMAR, PREETI

ART UNIT

PAPER NUMBER

1751

DATE MAILED: 07/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

13

**Office Action Summary**

Application No.

09/688,066

Applicant(s)

PROZZO ET AL.

Examiner

Preeti Kumar

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 May 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-5, 7-9 and 11-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-5, 7-9 and 11-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

1. Claims 2-5, 7-9 and 11-13 are pending.
2. The rejection of claims 2-5, 7-8 under 35 U.S.C. 103(a) as being unpatentable over Stringer et al. (US 5,858,955) is maintained for the reasons recited in the previous office action and further described below.
3. The rejection of claims 9 and 11-12 under 35 U.S.C. 103(a) as being unpatentable over Gosselink et al. (US 5,691,298) in view of Stringer et al. (US 5,858,955) is maintained for the reasons recited in the previous office action. Specifically regarding the newly added claim 12, Gosselink et al. teach a process for treating fiber materials wherein the preferred fiber is polyester, polyester-cotton blends, and other synthetic fabrics; best soil release results are achieved thereon, but other fabric types can also be present. See col.40, ln.5-10. The examiner asserts that other fabric types can encompass dyed and non-dyed fibers.

### ***Response to Arguments***

4. Applicant's arguments filed May 19, 2003 have been fully considered but they are not persuasive because the prior art made of record is sufficient to overcome the material limitations of the claims as amended. As clearly stated in prior office actions, Stringer et al. provide suggestion to incorporate components A-D in a composition for use in the pretreatment of fiber materials.
5. In response to applicant's argument that Stringer et al. do not exemplify a composition comprising A, B and C and the specific ratios thereof, the fact that applicant has recognized another advantage which would flow naturally from following the

Art Unit: 1751

suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Specifically regarding component A Stringer et al. teach the utility of sodium cumene sulfonate which meets the limitation of formula I as recited by the applicants in claim 8 and on page 11 of the specification. Specifically regarding component B, Stringer et al. teach the utility of primary aliphatic alcohol ethoxylates, and secondary aliphatic alcohol ethoxylates, alkylphenol ethoxylates. See col.5, ln.25-30. Specifically regarding component C, Stringer et al. teach the utility of a C10 -C16 alkanol condensate with ethylene oxide and propylene oxide, the weight ratio of ethylene oxide to propylene oxide being 3:1 and the total alkoxy content being about 75% by weight. See col.6, ln.34-36. Specifically regarding component D, Stringer et al. teach a light duty liquid cleaning composition comprising water. See col.4, ln. 48. Accordingly, Stringer et al. provide suggestion to incorporate components A-D in a cleaning composition.

6. In response to applicant's argument that Stringer et al. teach compositions for use on textile end products and thus, is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the instant pretreatment process is performed on fiber materials to remove impurities and the fabric care processes taught by Stringer et al. are also performed on fiber materials to remove

impurities. Furthermore, the recitation of "fiber materials in the form of textile sheets prior to manufacture of endues articles from the sheets" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

***Allowable Subject Matter***

7. Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Prior art made of record do not teach or suggest components A – F in the specific proportions as recited by claim 13.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Preeti Kumar whose telephone number is 703-305-0178. The examiner can normally be reached on M-F 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra N. Gupta can be reached on 703-308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Application/Control Number: 09/688,066

Page 5

Art Unit: 1751

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-872-9309.

Preeti Kumar  
Examiner  
Art Unit 1751

PK  
July 27, 2003



YUGEN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700